

CASE PI/5-20891/A/PCT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF
O'SULLIVAN ET AL.

Art Unit: 1613
Examiner: R. Gerstl

OFFICIAL

APPLICATION NO: 09/091,333

FILED: OCTOBER 26, 1998

FOR: PROCESS FOR THE PREPARATION OF 2-CHLORO-5-
CHLOROMETHYL-THIAZOLE

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Sir:

This is an ex parte appeal under 35 USC § 134 from the final rejection of November 5, 1999 issued by the primary Examiner, finally rejecting claims 1 - 7, 9, 12 and 13.

The Notice of Appeal and requisite appeal fee were mailed to the Patent and Trademark Office by first class mail with a certificate of mailing on May 5, 2000, date stamped as received on May 10, 2000 making the brief due on July 10, 2000. A Petition for Extension of time for one-month and the requisite fee therefor are attached hereto, thereby extending the period for filing this Brief until August 10, 2000.

(1) REAL PARTY IN INTEREST

By Assignment dated June 12, 1998, the present application was assigned to Novartis Crop Protection, Inc., which is an affiliate of Novartis Corporation, which is a wholly owned subsidiary of Novartis AG, Basle Switzerland.

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(2) RELATED APPEALS AND INTERFERENCES

To the best of Appellant's, Appellant's legal representative, and Appellant's assignee's knowledge there are no other appeals or interferences which will directly affect or be directly affected or have a bearing on the Board's decision on the pending appeal.

(3) STATUS OF THE CLAIMS

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Claims 1-68 were originally filed.

Claims 8, 11, 14, 17, 21, 25, 28, 32, 36, 39, 43, 47, 53, 57, 65 and 68 were canceled by amendment dated June 16, 1998.

Claims 15, 16, 18-20, 22-24, 26, 27, 29-31, 33-35, 37, 38, 40-42, 44-46, 48-52, 54-56, 58-64, 66 and 67 stand withdrawn pursuant to Rule 142(b).

Claim 10 was not rejected by the Examiner and is presumably allowed.

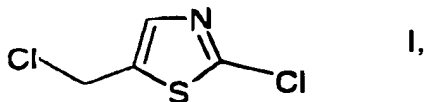
The claims on appeal, 1 - 7, 9, 12 and 13, stand finally rejected under 35 USC § 135(b)¹. A clear copy of the appealed claims appears in the Appendix.

(4) STATUS OF AMENDMENTS

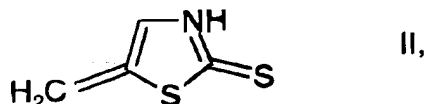
The claims were not amended in response to the final rejection. A Notice of Appeal was the sole response.

(5) SUMMARY OF THE INVENTION

The invention relates, *inter alia*, to a process for preparing a compound of the formula



which comprises reacting a compound of the formula



in free form or in salt form, with a chlorinating agent.

¹ The final rejection indicates that claims 1-6, 8(*sic* ??), 9, 12 and 13 are rejected.

The present invention also pertains to several alternative processes for preparing a compound of formula I.

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(6) ISSUES ON APPEAL

The final rejection raises a single issue.

ARE CLAIMS 1 – 7, 9, 12 and 13 UNPATENTABLE UNDER 35 USC §135(b) AS NOT BEING MADE PRIOR TO ONE YEAR FROM THE DATE ON WHICH U.S. PATENT NO. 5,679,796 WAS GRANTED?

(7) GROUPING OF CLAIMS

The claims do not stand or fall together. Each of the claims present different issues with respect to whether a proper case has been made out by the Examiner regarding their coverage of the "same or substantially the same subject matter" as the claim of the '796 patent. Accordingly, each claim should be considered separately.

(8) ARGUMENT

The Examiner finally rejected claims 1 – 7, 9, 12 and 13 under 35 U.S.C. §135(b) as not being made prior to one year from the date on which U.S. patent no. 5,679,796 ("the '796 patent") was granted.

Appellants base this appeal upon error that is apparent in the Examiner's erroneous application of § 135(b) of the patent statute. As no proper prima facie case of a § 135(b) statutory bar has been made out by the Examiner, the rejection fails and the Examiner should be reversed.

Section 135(b) of the U.S. Patent Statute reads in pertinent part:

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. (emphasis added)

First, although Appellants do not concede this point one way or the other with respect to the claims at issue, Appellants note that the Examiner has not properly established that each of the rejected claims are directed to the same or the substantially the same subject matter as the claim of the '796 patent. See In re Sasse et al., 207 USPQ 107 (CCPA 1980).

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Secondly, the dispositive issue in this case resides in the fact that claims 1 – 7, 9, 12 and 13 were made prior to one year from the date on which the '796 patent was granted.

More specifically, the present application 09/091,333 is a § 371 of International application no. PCT/EP96/05564 filed December 12, 1996 having a § 119(a) priority date of December 21, 1995 based on Swiss application no. 3636/95. The § 371 requirements of the above-identified application were met on October 26, 1998.

The cited U.S. patent 5,679,796 was granted on **October 21, 1997.**

Appellants concede that the § 371 date of **October 26, 1998** is 5 days after the one year anniversary of the '796 patent grant date.

However, as Appellants are in full compliance with 37 CFR § 1.495, the filing date of the present application with respect to 35 U.S.C. § 135(b) is the international filing date of **December 12, 1996; well before the grant date of the '796 patent.**

Apparently recognizing that Appellants have a filing date which antedates the issue date of the '796 patent, the Examiner argues that Appellants are not entitled to their filing date "because they failed to comply with 37 CFR 1.495(b)." The Examiner is incorrect.

Sections 495 (b) and (c) of 37 CFR state in pertinent part:

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)). The 30-month time limit may not be extended.

(c) If applicant complies with paragraph (b) of this section before expiration of 30 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497); applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 30 months after the priority date.

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Accordingly, Appellants have complied with § 495(b) in that:

- (1) A copy of the international application was timely communicated to the U.S. patent office by the International Bureau as shown on the form PCT/IB/308 of record, the applicants' transmittal letter dated June 16, 1998 (form PTO-1390-MOD) of record and as acknowledged by the U.S. patent office by notification dated October 19, 1998 (form PCT/DO/EO/905) of record.
- (2) The basic national fee was timely provided to the U.S. patent office by the applicants' transmittal letter dated June 16, 1998 (form PTO-1390-MOD) of record and as acknowledged by the U.S. patent office by notification dated October 19, 1998 (form PCT/DO/EO/905) of record.

Accordingly, Appellants are entitled to the international filing date of **December 12, 1996**; well before the grant date of the '796 patent.

Appellants note that an oath or declaration of the inventors was omitted in the applicants' transmittal letter dated June 16, 1998 (form PTO-1390-MOD) of record as acknowledged by the U.S. patent office by notification dated October 19, 1998 (form PCT/DO/EO/905) of record.

However, Appellants submitted the missing oath or declaration under the provisions of §495(c) as shown by the applicant's transmittal letter dated October 21, 1998 (form PTO-1390-MOD) of record as acknowledged by the U.S. patent office by notification dated December 8, 1998 (form PCT/DO/EO/903) of record.

In summary, as Appellants are in full compliance with the provisions of both §495(b) and §495(c), Appellants are entitled to their international filing date of **December 12, 1996**; well before the grant date of the '796 patent.

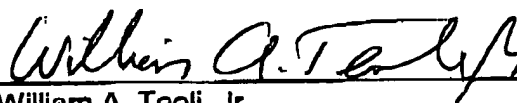
Accordingly, for the reasons above, Appellants respectfully submit that the § 135(b) rejection of claims 1 – 7, 9, 12 and 13 is in error as to fact and law and should be reversed.

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If any fee under 37 CFR § 1.17 is due in connection with this Appeal Brief, the Assistant Commissioner is authorized to charge Deposit Account No. 19-0134 in the name of Novartis Corporation for the appropriate amount.

Respectfully submitted,

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Date: August 10, 2000

ENCL. Appendix